--105. (New) The method of claim ~~61~~, wherein said ester bond is present in the structure D-Ala-D-Lac.--

--106. (New) The method of claim 61, wherein the agent is administered prior to administering the glycopeptide antibiotic.--

--107. (New) The method of claim 61, wherein the agent is administered a sufficient period of time prior to administering the glycopeptide antibiotic to permit cleavage of said ester bond to be effected.--

--108. (New) The method of claim 106, wherein the agent and the glycopeptide antibiotic are administered simultaneously.--

--109. (New) The method of claim 61, wherein the agent is covalently attached to the glycopeptide antibiotic.--

REMARKS

Claims 1-35, 42, 61, and 71-82 were pending in the subject application. By this Amendment applicants have canceled claims 5, 24, and 35 without disclaimer or prejudice to applicants' right to pursue the subject matter of these claims in the future and added new claims 83-110. Support for claims 83-100 can be found in the specification, *inter alia*, page 75, line 1 through page 77, line 26. Support for claims 101-109 can be found in the specification, *inter alia*, page 78, line 4 through page 79, line 11. Additionally, claims 83-100 correspond to claims 43-60, and claims 101-109 correspond to claims 62-70, which were canceled

without prejudice or disclaimer in the Preliminary Amendment filed August 23, 2001 with the subject application. Accordingly, upon entry of this Amendment, claims 1-4, 6-23, 25-34, 42, 61, and 71-109 will be pending and under examination.

Restriction Requirement

In the July 5, 2002 Office Action, the Examiner required restriction to one of the following allegedly independent and distinct inventions characterized by the following Groups I - VI:

I. Group I, Claims 1-4, 6-23, 25-34, 42, 61 and 72-78, drawn to methods for treating or killing an infection caused by a glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and an agent represented by formula S-Pro-Cn, classified in class 514, subclasses 2 and 425;

II. Group II, Claims 1-3, 5-22, 24-34, 42, 61 and 72-78, drawn to methods for treating or killing an infection caused by a glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and an agent represented by the structure of claim 5, classified in class 514, subclasses 2, 315, and 425; and

III. Group III, claim 35, drawn to a method for determining whether a test compound has certain properties, classified in class 435, various subclasses.

The Examiner alleged that the inventions of Groups I - III are independent and distinct, each from the other, as they have acquired separate status in the art as shown by their different classification and a separate subject matter for inventive effort.

The Examiner further alleges that a reference which anticipates any one of the above inventions would neither anticipate nor make obvious of the other inventions.

The Examiner alleged that these inventions are distinct for the reasons given above, and because each such invention is capable of supporting its own patent. Therefore the Examiner asserted that the restriction for examination purposes as indicated is proper.

In response, applicants hereby elect, with traverse, the claims of Group I, specifically claims 1-4, 6-23, 25-34, 42, 61, and 72-78.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application.

First, the inventions of the cited Groups are not independent. Under MPEP §802.01, "independent" means there is no disclosed

relationship between the subjects disclosed. Group I claims a method for treating or filling an infection caused by glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and an agent represented by the formula S-Pro-Cn. Group II claims methods for treating or killing an infection caused by a glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and an agent represented by the structure of claim 5. Group III claims a method for determining whether a test compound has certain properties. Groups I and II are necessarily related because both are drawn to methods for treating or killing an infection caused by a glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and another agent. Group III determines whether a test compound selectively cleaves an ester bond present between two amino acid-like moieties. Groups I and II deal with bacteria in which resistance is the result of the conversion of an amide bond to an ester bond. The methods of Groups I and II further involve the cleavage of the ester bond so as to treat the infection. Therefore, the method of Group III, which determines compounds that selectively cleaves a specific ester bond, is necessarily linked to the methods of Groups I and II, which require the selective cleavage of a specific ester bond. The Applicants therefore maintain that the cited Groups are not "independent".

Finally, under MPEP § 803, there are two criteria for a proper restriction requirement: 1) the invention must be independent or distinct, **and** 2) there must be a serious burden on the Examiner

if restriction is required. MPEP §803 unambiguously provides that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction is not required between Groups I-III because a search of the prior art relevant to any of the claims of any of the Groups would necessarily turn up the prior art relevant to the claims of the remaining Groups, and *vice versa* because all of the groups involve the treatment or killing an infection caused by a glycopeptide antibiotic resistant bacteria by administering a composition comprising vancomycin and another agent that will selectively cleave a specific ester bond. Since there is no burden on the Examiner to examine Groups I-III together in the subject application, it is submitted that the Examiner must examine the entire application on the merits.

SUMMARY

In view of the foregoing, applicants maintain that the July 5, 2002 restriction requirement is not proper under 35 U.S.C. § 121 and respectfully request that the Examiner reconsider and withdraw the requirement.

Information Disclosure Statement

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicant would like to direct the Examiner's attention to the following references, which are listed on Form PTO-1449